

### **REMARKS**

Applicants have amended the claims to combine claims 1 and 7 with claims 3 and 9, respectively, and to improve the claim language. Applicants have canceled claims 3 and 9 in view of these amendments and have rewritten non-elected claims 6 and 12 as product-by-process claims to make them consonant with the elected product claims. Applicants have also added new product-by-process claims 13 and 14 to round out the coverage to which they are entitled. No new matter has been added.

Claims 1, 3, 7 and 9 were rejected as anticipated by Taniguchi. The Examiner contended that Taniguchi discloses a non-woven fabric made of one or more lactic-acid based polymers containing more than 80 mol % of L- or D-lactic acid units or a polymer containing 85% L- or D-lactic acid units and 15% D- or L-lactic acid units. The Examiner called upon applicants to show that Taniguchi's fabric was not usable as an electret medium. This rejection is respectfully traversed.

The Examiner seems to have overlooked the requirement of original claims 3 and 9, now incorporated into base claims 1 and 7, that the polymer contain no more than 15% lactide. The Examiner has pointed to no reason to believe that Taniguchi discloses this requirement of the claims. As explained in this application, applicants have endeavored to reduce the amounts of low molecular weight components remaining in the lactic acid polymer so that there is no more than 15% lactide content. As set forth in new claims 13 and 14, applicants accomplish this goal by purifying the lactic acid polymer using recrystallization, heat distillation or reduced-pressure distillation to reduce residual low-molecular weight components. These steps produce electret media which demonstrate the claimed degree of crystallinity (endotherm) and charge stability, none of which (as the Examiner admits) Taniguchi hints at, presumably because Taniguchi does not disclose electret media at all. The applicable case law and MPEP provisions require the Examiner to set forth a reasoned factual basis to support any rejection based on inherency – which is the kind of rejection the Examiner is making here – yet the Examiner has not explained

why or how following Taniguchi's disclosure will *necessarily and inevitably* result in the claimed invention. See, MPEP 2131 ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." [Citation omitted; emphasis in original.]). Neither Taniguchi nor the Examiner's analysis of it meets the requirements for a proper anticipation rejection. This rejection should be withdrawn.

Claims 2, 4, 8 and 10 were rejected under 35 USC 102(b) or 35 USC 103(a) on Taniguchi, the Examiner taking the position that although Taniguchi fails to teach the claimed endotherm, crystal fusion and charge density, "it is reasonable to presume" that such properties are inherent in Taniguchi's fabric. This rejection and its supporting reasoning are respectfully traversed.

MPEP 2131 and the case law supporting it make it clear that the Examiner may not "presume" the existence of inherent disclosure as the basis for making a rejection, so this rejection fails as an anticipation rejection for failure of the Examiner to articulate a factual or reasoned basis for the finding of inherency. There is no basis in Taniguchi even for the "presumption" posited by the Examiner. The Examiner's position relies on mere speculation, nothing else.

Furthermore, applicants note that alleged inherent disclosure does not make out a case of *prima facie* obviousness where the presence of that inherent disclosure would not have been known to persons of ordinary skill in the art. There is no evidence on this record that persons of ordinary skill in the art would have been aware of the characteristics set forth in claims 2, 4, 8 and 10 as being embodied by the products of Taniguchi, meaning that there is no basis upon which the Examiner can properly find that the subject matter of the rejected claims as a whole would have been obvious to persons of ordinary skill in the art at the time the invention was made. Applicants respectfully suggest that the Examiner should consider the guidance in MPEP

2141.02, especially the discussion at page 2100-126, where the MPEP states, "Obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a certain feature is later established." There is no reason from Taniguchi to believe that it would have been obvious to produce electret media that exhibit the claimed properties. The Examiner admits that Taniguchi says nothing whatever about these properties to which the Examiner can point in support of the rejection.

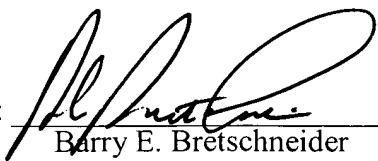
Finally, claims 5 and 11 stand rejected under 35 USC 103(a) on Taniguchi in view of Raetzsuch. This rejection should be withdrawn because Taniguchi does not provide evidence of the teachings for which it is cited.

Early action allowing claims 1, 2, 4-8 and 10-14 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 427972000600.

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